

III. REMARKS

1. Claim 1 is amended. Claims 10 and 11 are cancelled without prejudice. Applicant appreciates the indication of allowable subject matter in claims 3 and 6-8.

2. Claims 1, 2, and 5 are patentable under 35 U.S.C. 102(b) and 103(a) over Japanese Patent Publication 5-32231 ("Tetsuya"). Claim 1 recites a separator for separating folded envelope flaps from envelope bodies, of which an active zone of separation comprises a supple part. This feature is not disclosed or suggested in Tetsuya.

In Tetsuya, the envelopes are loaded into the copier (2) in an "open" configuration in that the flap (Pfc) is not folded to block the envelope opening (Pon), thus there is no "folded" flap to separate from the envelope body (See Fig. 4). Applicant's claim 1 recites the separation of folded envelope flaps. There is absolutely no disclosure whatsoever in Tetsuya of separating folded envelope flaps from envelope bodies. All that is disclosed in Tetsuya is that an open envelope is fed such that a mylar opening member (61) is slid inside the envelope opening to allow the insertion of items into the envelope, which as noted above is already in an "open" configuration (See Figs. 9-12; Para. 0038-0041).

As argued in Applicant's prior response, in order for the opening members (61) of Tetsuya to open a "folded" envelope flap as recited in Applicant's claim 1, the envelope in Tetsuya would have to be fed with the flap (Pfc) in a leading position so that when the direction of the rollers (59, 60) are reversed the opening member (61) peels the envelope flap open. However, the configuration of the copier (2) is not physically capable of

inserting paper into the envelopes if the flap were in a leading position. If the envelopes were fed with the flap (Pfc) in the leading position the paper would not be inserted into the envelope, but rather as can be seen by the copier configuration in Figure 1 of Tetsuya, the paper would slide down between the side of the envelope and the opening member (61) past the envelope opening (Pon) (i.e. the paper feed direction and the envelope opening (Pon) would both be in the same direction making the insertion of the paper into the envelope impossible). Thus, the modification of Tetsuya would not be a simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement. The configuration of Tetsuya itself effectively teaches away from what is claimed in Applicant's claim 1.

Although claim 1 is amended to further define the separation of the envelope flaps from the envelope bodies, it is noted that the term "separating" with respect to separating envelope flaps from envelope bodies as used in the art does not include a "distancing" of the open envelope flap "from the opposite side of the envelope so sheets of paper can be automatically inserted" as shown in Figure 12 of Tetsuya. Tetsuya discloses nothing more than the insertion of sheets in an envelope where the opening in the envelope is widened by the mylar member (61) to allow the insertion of the paper. The envelope flap (Pfc) of Tetsuya cannot be "separated" from the envelope body as that term is used in the art because the flap (Pfc) is already in an opened configuration.

There is simply no disclosure or suggestion in Tetsuya of a separator for separating folded envelope flaps from envelope bodies. Thus, claim 1 is patentable for at least this reason.

Further, claim 1 recites that the supple part deforms causing the separator to allow an improperly closed flap to pass by the separator. There is absolutely no disclosure or suggestion of this feature in Tetsuya. As described above, the envelopes in Tetsuya are fed through the copier in an open configuration with envelope flap (Pfc) in a trailing position so that the mylar opening member (61) can be inserted into the envelope opening. Nowhere does Tetsuya even address "improperly closed envelope flaps". Thus, claim 1 is patentable for this additional reason.

Therefore, claim 1 is not anticipated by or obvious over Tetsuya and the rejection should be withdrawn. Claims 2 and 5 are patentable at least by reason of their respective dependencies.

With respect to claim 5, Tetsuya does not disclose or suggest that a "supple part" of the opening members (61) "is detachable from a rigid part of the separator" as recited in claim 5. All that is disclosed in Tetsuya is that the opening member (61) is formed of a resin material in the shape of a thin film and that the upper part of the opening member (61) is fixed. There is no disclosure in Tetsuya that the opening member (61) can "accommodate" and be removed from "a rod" as suggested by the Examiner. Thus, claim 5 is patentable for this additional reason.

3. Claim 4 is patentable under 35 U.S.C. 103(a) over Tetsuya and U.S. Patent 5,021,279 ("Whitener") or U.S. Patent 5,922,591 ("Anderson"). For the reasons described above Tetsuya does not disclose or suggest all the features of claim 1. It is submitted that because Tetsuya does not disclose all the features of claim 1 that the combination of Tetsuya and either Whitener or Anderson cannot as well. Thus, claim 4 is patentable at least by reason of its dependency.

Further, it is submitted that Tetsuya and either Whitener or Anderson have been combined improperly. References may be combined under 35 U.S.C. 103(a) only if the references are analogous art. In this case Whitener and Anderson are not analogous art. A reference is analogous art if:

- 1) The reference is in the same field of endeavor as the applicant's; or
- 2) The reference is reasonably pertinent to the particular problem with which the applicant was concerned.

Neither Whitener nor Anderson are in the same field as the Applicant's. Whitener discloses an edge protection apparatus (i.e. edge molding) for protecting a surface of an object to which the molding is attached and nothing more (Abstract).

Anderson discloses a miniaturized integrated nucleic acid diagnostic device and system (Abstract).

The edge protection apparatus of Whitener and the nucleic acid diagnostic device and system of Anderson are clearly not the same fields of endeavor as Applicant's. Neither Whitener nor Anderson are concerned with separating flaps of envelopes as called for in Applicant's claims.

Moreover, Whitener and Anderson are not reasonably pertinent to the problem with which Applicant was concerned. Applicant was concerned with separating envelope flaps from envelope bodies. Again, Whitener is merely concerned with protecting a surface of an object to which an edge protection apparatus is attached while Anderson is concerned with a miniaturized integrated nucleic acid diagnostic device and system.

Since Whitener and Anderson are not in the same field of endeavor and are not reasonably pertinent to the particular problem with which Applicant was concerned, Whitener and Anderson are not analogous art. Therefore, Whitener or Anderson may not be properly combined with Tetsuya.


Moreover, there is no motivation to combine Tetsuya with Whitener or Anderson because Whitener and Anderson are not even remotely associated with separating envelope flaps from envelope bodies. Further, there is absolutely no disclosure of envelopes in either Whitener or Anderson.

Thus, claim 4 is not obvious over Tetsuya and either Whitener or Anderson for these additional reasons.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,


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